

REMARKS

I. Status of the Application

Claims 26, 28-30, 33-37, 39 and 41-50 are pending in the application, of which claims 26, 42, and 48 are independent claims.

Claims 26, 33, 37, and 42-50 have been amended. All amendments are supported by the application and claims as originally filed. No new matter has been added.

Accordingly, entry of the amendments is respectfully requested. Applicants have amended the claims to recite particular embodiments that Applicants, in their business judgment, have determined to be commercially desirable at this time. The claim amendments have not been submitted for any reasons relating to patentability.

In a Final Office Action dated April 30, 2008 ("Office Action"), the Examiner rejected all of claims 26, 28-30, 33-37, 39 and 41-50 under 35 U.S.C. §103(a) as being unpatentable over U.S. 6,195,647 ("Martyn") in view of U.S. Patent Publication 2002/0161690 ("McCarthy"), either taken together or further in view of U.S. Patent Publication 2006/0069635 ("Ram"). Applicants submitted a Pre-Appeal Brief Request for Review on September 2, 2008. The Patent Office denied Applicants' Request for Review in a Notice of Panel Decision dated September 19, 2008.

Applicants respectfully contend that the rejection of these claims on the grounds presented in the Final Office Action contain clear legal and factual deficiencies.

II. The Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 26, 28-30, 33-37, 39, and 41-50 under 35 U.S.C. §103(a).

1. Certain Limitations are Not Disclosed in the Cited References

As amended, independent claims 26, 42, and 48 recite “receiv[ing] by a computing device a selection of a quadrant from a plurality of quadrants, in which each quadrant comprises a portion of a customizable display and each quadrant comprises a benchmark instrument.” The cited references do not disclose or suggest at least this recitation.

Applicants note that the Examiner asserts that “selecting a quadrant from a plurality of quadrants . . . in which . . . the selected quadrant comprises a benchmark instrument” is disclosed by Martyn at column 11, lines 43-44, which states, “[t]icker window 12000 displays every trade and quote update for all or a selected portion of all securities.” However, the cited portion of Martyn does not disclose or suggest the recitation quoted above.

When a claim recites a limitation that is absent from the art, the claim is not obvious. MPEP §2143.03; *Motorola v. Interdigital Technology Corp.*, 121 F.3d 1461, 1466-67, 43 USPQ2d 1490, 1490-91 (Fed. Cir. 1997) (reversing a jury verdict of obviousness because an element was not taught in the particular art relied upon, even though that element was known elsewhere). Therefore, the Office Action fails to make a *prima facie* showing of obviousness for claims 26, 42, and 48.

1. There is No Substantial Evidence of Motivation to Modify Martyn

On page 3, the Final Office Action concedes that Martyn does not disclose various recitations of independent claims 26, 42, and 48, which are incorporated by reference in claims 28-30, 33-37, 39, 41, 43-47, and 49-50. After asserting that McCarthy discloses these features, the Final Office Action argues – in a single, conclusory sentence – that one of ordinary skill in the art would be motivated to modify Martyn to incorporate these features for the following reason:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Martyn et al. to include non-benchmark securities related to specific trading criteria (i.e., benchmark security), the benchmark security and non-benchmark security make up different financial instruments, and displaying the market data in grids as taught by McCarthy et al. *in order to allow a trader to use various trading*

interfaces to create orders, manipulate orders, cancel orders, cycle through multiple issues, obtain trading information more relevant than limit price stacks, or efficiently buy or sell items inside or within a spread market.

Final Office Action, pp. 3-4 (emphasis added). Accordingly, the Examiner asserts that one of ordinary skill in the art would be motivated to modify Martyn for the sole reason that such combination would achieve various benefits, including the ability to create and cancel orders.

The Examiner's proffered motivation is a finding of fact, and all findings of fact by the U.S. Patent and Trademark Office must be supported by substantial evidence within the record. *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). The Supreme Court has described "substantial evidence" in the following manner: "substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence." *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229, 83 L. Ed. 126, 59 S. Ct. 206 (1938); *see also Dickinson v. Zurko*, 527 U.S. 150, 162, 50 U.S.P.Q.2D 1930, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) ("*Zurko III*").

However, the Examiner's proffered motivation lacks substantial evidence within the record. The Examiner has not cited any references or any other authority for the list of benefits cited, or for the proposition that these benefits would motivate one of ordinary skill in the art to selectively modify Martyn to incorporate specific features of McCarthy in order to achieve the claimed invention. In fact, the Examiner's single, conclusory assertion concerning a motivation to modify Martyn provides no evidence or support whatsoever. The Examiner has therefore failed to establish a *prima facie* case of obviousness for claims 26, 42, and 48. Applicant demands that the Examiner produce evidence for the proffered motivation if the rejections are to be maintained. Even if a rejection is maintained or raised, Applicant submits that final rejection here is premature.

2. There is No Rational and Articulated Reason to Combine References

Furthermore, the rejection of claims 26, 42, and 48 is improper because the Examiner's unsupported assertion fails to provide a rational and articulated reason for combining the teachings of Martyn and McCarthy. "[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, -- U.S. --, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must explicitly articulate the reasoning for combining teachings from different references. The Federal Circuit stated:

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *To facilitate review, this analysis should be made explicit.*

KSR Int'l Co., 127 S.Ct. at 1740-41 (emphasis added). Vague and conclusory statements are insufficient to establish a reason for combining the teachings of different references. See *Innogenetics*, 512 F.3d at 1373-74 (excluding obviousness testimony that was "vague and conclusory" regarding the motivation to combine references). Here, the Examiner's single, conclusory assertion that various benefits would motivate one of ordinary skill in the art to selectively modify Martyn to incorporate specific features of McCarthy is "vague and conclusory," at best. Therefore, the proposed combination of Martyn and McCarthy is improper.

For at least these reasons, the rejection of claims 26, 42, and 48 (and the claims depending therefrom) should be withdrawn.

Applicant submits that these claims are patentable for the reasons discussed above with respect to claim 26, and further due to the additional features that they recite.

E. General Comments on Dependent Claims

Applicant submits that the claims depending from independent claims 26, 42, and 48 are patentable for the reasons discussed above and further due to the additional features that they recite. Since each of the dependent claims depends from a base claim that is believed to be in condition for allowance, Applicants believe that it is unnecessary at this time to argue the allowability of each of the dependent claims individually. However, Applicants do not necessarily concur with the interpretation of the dependent claims as set forth in the Office Action, nor do Applicants concur that the basis for the rejection of any of the dependent claims is proper. Therefore, Applicants reserve the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

CONCLUSION

In general, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in this paper or documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account No. 50-3938. Applicants' undersigned attorney can be reached at the address shown below. All telephone calls should be directed to the undersigned at (212) 294-8055.

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Respectfully submitted,

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